

REMARKS

Reconsideration of the instant application is respectfully requested. The present amendment is submitted in conjunction with a Request for Continued Examination (RCE), pursuant to 37 CFR 1.114. The RCE is submitted in response to the Final Office Action of June 29, 2004, in which claims 1-7 and 9-20 are presently pending. Of those, claim 3 has been rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter regarded as the invention.

With regard to the art of record, claims 1-3, 9, 10, 15 and 16 have been rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent 5,260,949 to Hashizume, et al. In addition, claims 4-7, 11-14 and 17-20 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Hashizume, et al., in view of U.S. Patent 5,983,380 to Motika, et al. For the following reasons, however, it is respectfully submitted that the application is now in condition for allowance.

As an initial matter, the §112, second paragraph rejection of claim 3 has been overcome by the amendment thereto, which deletes "the logic structure" and substitutes -- a logic structure--.

As to the substantive §102 and §103 rejections of the presently pending claims, the Applicants have overcome the same by virtue of the present amendments to independent claims 1, 9 and 15, which now recite a separate (second) scan chain in conjunction with the select mechanism that comprises the normal data path for the second (or subsequent) register. Support for these amendments is found at least in paragraph [0029], pages 8-9 of the specification, and Figure 5, as was also discussed during the teleconference on August 18, 2004, between the undersigned, the Applicant and the Examiner.

In other words, the claims now recite that the first and second registers are a part of a separate scan chain, as set forth in the embodiment of Figure 5 (e.g., the data passed through master register 12 comes from a first scan chain 10, while the normal data path through shadow register 14a is through a second scan chain 10a, which is separate from first scan chain 10).

In contrast, the newly cited reference (Hashizume) only teaches a single scan chain as a "normal" source of data to the "second" register 2b, which is serially connected to the output of "first" register 2a. In other words, this is a serial connection that forms a single scan chain and thus does not provide for a second scan chain as is now claimed. Therefore, since Hashizume does not teach or suggest a second scan chain as a normal data path for a second register, the §102 and §103 rejections to each of the presently pending claims have been overcome.

For the above stated reasons, it is respectfully submitted that the present application is now in condition for allowance. No new matter has been entered and no additional fees are believed to be required. However, if any fees are due with respect to this Amendment, please charge them to Deposit Account No. 09-0463 maintained by Applicants' attorneys.

Respectfully submitted,
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